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IBM Docket No.: AUS920031011US1(4032)

REMARKS

Claims 1-21 are pending and claims 1-21 stand rejected. In a previous Office action mailed November 16, 2004, the Office action rejected claims 1-5 and 7-24 under 35 USC § 102(e) as being unpatentable over Whitham U.S. Pat. 6,526,351 (hereinafter "Whitham") and further rejected claim 6 under 35 USC § 103(a) as being unpatentable over Whitham in view of Bodin U.S. Pat. 6,813,559 (hereinafter "Bodin"). In a Response dated February 15, 2005, Applicant amended independent claims 1, 11 and 19 solely to provide further clarification of the invention and requested reconsideration of the rejections.

In a final Office action mailed May 18, 2005, the Office action rejected claims 22 and 24 under 35 USC § 102(e) as being unpatentable over Whitham. The Office action further rejected claims 1-5, 7-21, and 23 under 35 USC § 103(a) as being unpatentable over Whitham in view of Trossen U.S. Pat. Application Publication US 2005/0059410 A1 (hereinafter "Trossen"). The Office action further rejected claim 6 under 35 USC § 103(a) as being unpatentable over Whitham in view of Trossen and further in view of Bodin. In a Response dated July 18, 2005, Applicants requested cancellation of claims 22-24, submitted a declaration under 37 C.F.R. § 131 establishing the invention of the subject matter of the rejected claims as on or before August 22, 2003, and requested further reconsideration of claims 1-21. The Advisory Action of August 2, 2005 rejected the proposed claim cancellation and maintained the previous rejections.

Applicants appealed the Final Office action and filed an Appeal Brief on October 18, 2005. In the present Office action mailed March 7, 2006, the Office action removed the finality of the previous Office action and rejected pending claims 1-24 of the present application. The Office action rejected claims 1, 22, and 24 under 35 USC § 102(e) as being unpatentable over Whitham. The Office action further rejected claims 2-21 and 23 under 35 USC § 103(a) as being unpatentable over Whitham in view of Bodin.

In this Response, Applicants have canceled claims 22-24 and amended claims 1, 11, and 19, support for which can be found for example in the Specification at paragraphs 26 and 41, for example, and throughout the Specification as filed. In light of cancelled claims 22-24, the rejections of claims 22-24 in the present Office action are now moot and will not be specifically

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addressed. Applicants respectfully believe that the rejections of pending claims 1-21 have been traversed in light of the amendments and/or the following remarks. All of the pending claims in the present application are believed to be patentable over any combination of these references and the Examiner's reconsideration is respectfully requested.

Claim rejections under 35 USC § 102

Pending claim 1 stands rejected under 35 USC § 102(e) as being anticipated by Whitham. Applicant respectfully contends that the rejection with respect to claim 1 is traversed in the following remarks.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.¹ Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.²

Claim 1

In regards to amended independent claim 1, the Office action fails to establish a prima facie case of anticipation by Whitham because citations of Whitham provided as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]". In particular, amended claim 1 states:

receiving from a user at a current location differential information, the differential information indicating a difference between the current location and a particular, different location....

Whitham, in contrast, does not disclose or suggest receiving differential information *from a user* at a current location. Instead, Whitham teaches an interactive media guide that provides directions, including a distance, *to a user*. (Specification, column 5, lines 35-42). As the Office action concedes by noting that the "patented interactive multimedia guide produces a distance by using 2 different locations", the system provides the distance, not the user. (See Office action, page 3, Section 5A). While Whitham does teach an interactive multimedia guide system

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

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providing a distance between a user's current location and another location, Whitham does not disclose or suggest receiving differential information *from a user* and is thus readily distinguishable from the present invention. Moreover, the distance of Whitham is not differential information as claimed in amended claim 1 as it is one of the result of a location-based service, not the basis for a location-based service.

Neither does Whitham disclose or suggest the element of amended claim 1 requiring "receiving from the user at the current location a request to receive a location-based service based on the particular, different location". Instead, Whitham teaches receiving requests to provide a location-based service based on the *current* location of the user and does not teach receiving requests to provide a location-based service based on the *particular, different* location. (Specification, column 4, lines 24-38). For example, Whitham discloses receiving a voice command from a user to zoom in on a map "to better show the immediate surroundings of the user's current location." (Specification, column 4, lines 29-32). In another example, a user of the Whitham system may request restaurant recommendations that are "reasonably close" to the user's *current* location or "in the vicinity" of the user (Specification, column 5, lines 33-45). Whitham simply does not disclose or suggest receiving from the user at the current location a request to receive a location-based service based on the particular, different location.

Neither does Whitham disclose or suggest the element of amended claim 1 requiring "providing a location-based service based on the particular, different location". Instead, Whitham teaches providing a location-based service based on the *current* location of the user and does not teach providing a location-based service based on the *particular, different* location. (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45 and Specification, column 3, lines 60-63). For example, Whitham discloses providing restaurant recommendations that are "reasonably close" to the user's *current* location or "in the vicinity" of the user (Specification, column 5, lines 25-45). Whitham also teaches a service with "primary destinations in a given tour" and "ancillary points of interest" of a pre-defined tour (Specification, column 3, lines 20-42). The ancillary points of interest taught by Whitham are the *results* of a location-based service and not the *basis* for one and thus are not a "particular location" as defined in claim 1 as the ancillary points of interest are predefined for a tour and not the result of a determination made in response to "differential information received from a user".

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Whitham's location-based service is based on the user's current location and the ancillary points of interest are the results of that location-based service. Whitham does not disclose or suggest providing a location-based service based on the particular, different location to a user at a current location, particularly where the particular, different location is determined based on differential information received from a user.

Whitham simply does not teach or suggest, expressly or inherently, the teachings of amended independent claim 1. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn and that claim 1 be allowed.

Claim rejections under 35 USC § 103(a)

Claims 2-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitham in view of Bodin. Applicants respectfully contend that claims 2-21 are patentable as none of the disclosed and applicable references, alone or in combination, disclose or suggest the limitations of the claims as amended, and Applicants accordingly respectfully request that the rejections be removed and the claims allowed. Applicant respectfully contends that the rejections with respect to claims 2-21 are traversed in the following remarks.

To establish a *prima facie* case of obviousness, three basic criteria must be met.³ First, there must be a suggestion or motivation to modify or combine the references.⁴ Second, there must be a reasonable expectation of success in the modification or combination.⁵ Finally, the modification or combination must teach or suggest all of Applicants' claim limitations.⁶

Bodin teaches a methodology for navigating an unmanned aerial vehicle (UAV) to a particular waypoint via a pilot at a distant location. (*See*, generally, Specification, Abstract and FIG. 1). The UAV of Bodin does utilize a GPS receiver for navigational purposes (see Specification, column 5, lines 50-53). Bodin does not disclose or suggest requesting or providing a location-based service based on a particular, different location as understood in the claimed invention and instead discloses a remote control system for a UAV. To the extent that

³ Manual of Patent Examining Procedure §2142.

⁴ *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

⁵ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

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Bodin has a user, that user is by definition remote from the UAV with GPS receiver and communicating with the UAV via a wireless network. Bodin is simply not relevant to the present claimed invention.

As will be described in more detail, the Office action fails to satisfy the criteria required to establish a *prima facie* case of obviousness. First, there is no suggestion or motivation in either Whitham or Bodin to modify or combine the teachings of Bodin with those of Whitham and the Office action has failed to establish such. Moreover, the modification or combination of Whitham and Bodin does not teach or suggest all of the limitations of claims 2-21, as Bodin does not satisfy the deficiencies of Whitham. Even if Bodin helped solve the deficiencies of Whitham, there is no suggestion or motivation to combine the remote control system for UAVs of Bodin with the interactive multimedia guide of Whitham, making their combination improper.

Claims 2-10

As described previously in relation to claim 1, Whitham does not teach or suggest multiple limitations of amended claim 1. Bodin does not cure the deficiencies of Whitham as Bodin does not disclose or suggest many if not all of the elements of claim 1, including the limitations described previously in relation to claim 1 that Whitham fails to disclose or suggest. Bodin's remote control system for a UAV does not provide the necessary limitations to disclose or suggest the limitations of amended claim 1. Accordingly, neither Whitham nor Bodin teach or suggest, alone or in combination, multiple limitations of amended claim 1 and the Office action therefore fails to establish a *prima facie* case of obviousness by Whitham in view of Bodin for amended claim 1 and its dependent claims because citations of Whitham and Bodin provided as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]". Further, claims 2-10, being dependent upon claim 1, incorporate the limitations of amended claim 1 and are patentable for the same and additional reasons. The Office action's individual rejections of particular dependent claims 2-10 are now moot in light of the arguments presented above and need not be addressed. Applicant therefore respectfully requests that the rejections of claims 2-10 be withdrawn and claims 2-10 be allowed.

⁶ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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Claims 11-18

Similarly, neither Whitham nor Bodin teach or suggest, alone or in combination, all of the limitations of amended independent claim 11 for the reasons as described previously regarding claim 1, among other reasons. In particular, neither Whitham nor Bodin teach or suggest "a user interface for receiving user input, wherein the user input comprises differential information" and, as taught by independent claim 11, as the interactive multimedia guide of Whitham does not provide receiving differential information *from a user*, instead only teaching displaying directions and a distance to the user. (See Office action, page 3, Section 5A). In addition, neither Whitham or Bodin disclose or suggest the user input comprising "a request for a location-based service based on the particular, different location". (Specification, column 4, lines 24-38). Neither does Whitham disclose or suggest a "service module providing a location-based service based on the particular location" as taught by amended independent claim 11. As described previously, Whitham teaches providing information based on the *current* location of the user (Specification, column 4, lines 39-55; *see also*, Specification, column 5, lines 25-45) and does not disclose or suggest providing a location-based service based on a particular, different location. Accordingly, Applicant respectfully requests that the rejection of claim 11 be withdrawn and that claim 11 be allowed.

Further, claims 12-18, being dependent upon claim 11, incorporate the limitations of amended claim 11 and are patentable for the same and additional reasons. The Office action's individual rejections of particular dependent claims 12-18 are now moot in light of the arguments presented above and need not be addressed. Applicant therefore respectfully requests that the rejections of claims 12-18 be withdrawn and claims 12-18 be allowed.

Claims 19-21

In addition, neither Whitham nor Bodin teach or suggest, alone or in combination, multiple limitations of amended claim 19 for the reasons described above for claim 1 as well as other reasons. Further, claims 20-21, being dependent upon claim 19, incorporate the limitations of claim 19 and are similarly allowable. The Office action's individual rejections of particular dependent claims 20-21 are now moot in light of the arguments presented above and need not be

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addressed. Accordingly, Applicant respectfully requests that the rejection of claims 19-21 be withdrawn and that claims 19-21 be allowed.

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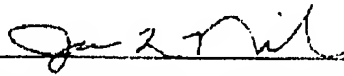
CONCLUSION

In the present response, Applicants responded to the Office action's claim rejections under 35 USC §§ 102 and 103. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the present Office action. Applicants believe that the pending claims are in condition for allowance and, accordingly, Applicants request that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (207) 322-1351.

Respectfully submitted,

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Date



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